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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,232	02/28/2002	Leslie Dort	45074-70	7803
<div>23971      7590      07/12/2007</div> <div>BENNETT JONES C/O MS ROSEANN CALDWELL 4500 BANKERS HALL EAST 855 - 2ND STREET, SW CALGARY, AB T2P 4K7 CANADA</div>				
			<div>EXAMINER</div> <div>BROWN, MICHAEL A</div>	
			<div>ART UNIT</div> <div>3772</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>07/12/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/084,232

Applicant(s)

DORT, LESLIE

Examiner

Michael Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 12-16, 19-22, 24-26, 28-30, 32-39, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 13-14, 32-39 and 44-45 is/are allowed.
- 6) ☒ Claim(s) 7-10, 12, 15, 16, 19-22, 24-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

**NOTE:** Although all claims in this case had been previously allowed, during a final review of the case a prior art reference was discovered and used in a new rejection. The examiner apologizes for any inconveniences incurred by the attorney or the applicant because of this decision.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Forman.

Forman discloses in figures 1-2 a mouthpiece that anticipates a device for retaining a tongue in a pre-determined position comprising a single flange 16 having a first and second surface fig.1, the flexible is substantially flexible and sized and shaped to be comfortably received between a person's lips and frontal surface of a person's teeth (col. 3, lines 26-30), an aperture (the aperture in side of 16), having a distal end (the end away from flange 16) and a proximal end (the end next to the flange 16), disposed in the flange, the aperture includes walls (the walls of 14), extending from a first surface of the flange, the walls forming a bulb (bulb can be interpreted as a circular member), protruding from the first surface of the single flange. The aperture is capable of receiving a user's tongue. The flange and bulb are formed from a molded one-piece

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body (fig. 1). The bulb can form a vacuum (sealing a person's lips against the bulb, col. 3, 30-34) and the walls form a smooth continuous surface with the first surface of the single flange (fig. 1). The proximal end of the aperture is radiused for providing a smooth continuous surface with the second surface of the single flange. The distal end of the aperture is radiused for providing a smooth continuous surface with the walls of the bulb.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 15-16, 19-22, 24-26, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forman in view of Scarberry.

Forman discloses in figures 1-2 a mouthpiece that anticipates a device for retaining a tongue, substantially as claimed. However, Forman doesn't disclose the molded one-piece body formed of urethane. Scarberry teaches in figure 4 a device for retaining a tongue comprising an integrally molded one-piece body made of urethane (polyurethane, col. 5, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the mouthpiece disclosed by Forman could be fabricated of polyurethane as taught by Scarberry because it is a flexible material that is capable of receiving the tongue and protecting the teeth. The means of forming the molded one-piece body are old and well known in the mouthpiece

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art. The thickness of the molded one-piece body is a design choice that provides no novelty over the prior art. The thickness of the one-piece molded body being constant is a design choice. The single flange is adjustable (movable inside of the mouth). The chamber of the device has a predetermined volume that a predetermined amount of a user's tongue will fit inside. The chamber is sized and shaped to receive the tongue and the aperture is elongated and shaped to receive a person's tongue. Note: Reference number 22 in Forman is shaped similar to a person's tongue.

***Allowable Subject Matter***

Claims 1-5, 13-14, 32-39 and 44-45 are allowed.

***Conclusion***

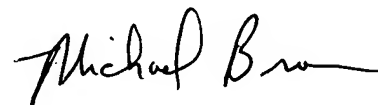
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Brown  
July 8, 2007

A handwritten signature in black ink, appearing to read "Michael Brown", with a stylized flourish at the end.

MICHAEL A. BROWN  
PRIMARY EXAMINER